



Docket No. 70301.56223

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: BIEDERMANN, et al. **EXAMINER:** A. Stewart
SERIAL NO. 09/914,256 **GROUP:** 3738
FILED: August 22, 2001
FOR: FOOT PROSTHESIS

T. H.
10-25-02
#8 / 109
for
Ken

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: BOX AMENDMENT Commissioner for Patents, Washington, D.C. 20231 on October 15, 2002.

By: Denise A. Rose
DENISE A. ROSE

COMMISSIONER FOR PATENTS
WASHINGTON, DC 20231

Sir:

REQUEST FOR RECONSIDERATION

In the office Action dated October 17, 2002, claims 9-18 are pending, claims 12, 14 and 16 are withdrawn from consideration, and claims 9-11, 13, 15, 17 and 18 are rejected. Claims 12 and 16 are indicated to have allowable subject matter but depend from a rejected claim. Applicants appreciate the acknowledgement of patentable subject matter. However, claim 14 is included with claim 9 in a rejection.

Claims 10 and 11 are rejected under 35 USC §112, second paragraph. The Examiner alleges that the claims do not clearly point out the subject matter. The Examiner states:

Claim 10 is not understood. The ground-side surfaces are not facing each other (see Fig. 1). The opposite surfaces are the one who are facing each other at the lower end region (see Fig. 1) held by the adapter.

Applicants strongly disagree with the Examiner. Applicants respectfully submit that the claims are very clear. The Examiner appears to have misconstrued the term "ground-side surface" used in claim 10 and 11 with the "ground-side free-ends 3, 6" on page 2, paragraph 2 of the present application.

The ground-side surface, however, is the one out of two surfaces of a leaf spring that is facing towards the ground. In the above mentioned paragraph (page 2), it also is called a "convex-side surface". Thus, the ground-side surfaces of the spring elements extend from the ground-side end 3 to the free end 4 and from the ground-side end 6 to the free end 7, respectively. The free ends 4 and 7 rest against each other and are attached so that the ground-side surfaces of the spring elements face each other. With this explanation, it is believed that this rejection is moot. However, if the Examiner still considers that there is an issue, it is requested that he call Applicants' attorney to discuss and attempt to resolve the issue.

Claims 9-11, 13, 15, 17 and 18 are rejected under 35 USC §102(e) over Christensen (US Patent 5,944,760). However, the structure of the prosthetic foot according to US 5,944,760 is substantially different from the present invention. In Christensen, the prosthetic foot consists of forefoot members (20, 22; col.5, lines 25-45, Fig. 1 and 2) with an arc portion (34) as first spring elements and heel members (40, 42; col.6, lines 7-13, Fig. 1 and 2) connected to the forefoot members at the arc portions as second spring elements.

Applicants strongly disagree with the handwritten interpretation entered in Fig. 14. The heel region is **not** located at 122 but, instead, at 48 where the heel member touches the ground. The second spring element is **not** the reinforcement member 120 (which does not touch the ground at all) but, instead, is the heel member 42. The reinforcement member 120 is used only for improved stability and is connected to the forefoot member on both its sides by a strap 128 at the attachment location 26 and by a resin impregnated fiber 50 near the arch section 34 of the forefoot member 22 (see col.9, lines 34-48).

Moreover, the ground-side surfaces of the first and second spring element are not facing each other but, instead, the ground-side surface of the forefoot members (first spring elements) faces the surfaces averted from the ground of the heel members (second spring elements) and of the reinforcement member.

More particularly, there is **no tension element** disclosed in US 5,944,760. The resin impregnated fiber 50 wrapped around forefoot member 22 and heel member 42 near the arch section 34 of the forefoot member 22 can be regarded **in no way** as a tension element connected to a forward region of the first spring element and to a heel region of the second spring element. It is used to **fixedly attach** the heel member to the forefoot member, but this connection also may be achieved by bolting or by forming the heel members integrally with the forefoot members (see col.6, lines 24-31). Thus, there is no hint of a suggestion for a tension element. Instead, Christensen element 50 resembles the attachment device comprising the adapter 5 and the locking screw 8 in the present application.

Thus, it is respectfully submitted that Christensen (US 5,944,760) **fails** to teach or suggest the present invention to one of ordinary skill in the art.

Claims 9 and 14 are rejected under 35 USC §102(b) over Wilson et al (US Patent 5,116,384). The structure of the prosthetic foot described by Wilson et al also is substantially different from the present invention. the main element of the Wilson et al prosthetic foot is a plantar member 12 extending from a toe region 22 to a heel region 14 with bent portions 18 and 19, which is used a base for building the rest of the structure on it (see col.3, lines 12-26, Fig. 1 and 2). This plantar member may be regarded as a first spring element. However, it **fails** to extend to a lower leg region.

Upon this plantar member 12, a rigid pylon 28 is mounted and connected to the plantar element at a distance that is 20% of the total length away from the heel region (see col.3, lines 52-68). This pylon can be regarded in no way as a spring element. Because the reference numeral 10 is used for the entire prosthetic foot, the element 10 in Fig. 1 mentioned by the Examiner seems to be the dorsal member 48, which is connected to the rigid pylon 28 at the lower leg region and to the plantar member 12 at a location between the toe region 22 and the arch portion 18 (see col.4, lines 42-52, Fig.6). This dorsal member, however, is no integrating component of the prosthetic foot because it **fails** even to touch the ground, but is only used for stabilizing the structure.

Further, the rigid pylon 28 **fails** to extend to the heel region 14, and the dorsal member **fails** to extend to the toe region 22. The plantar member 12 extends both to the heel region 14 and to the toe region 22, but it **fails** to extend to the lower leg region.

More particularly, there is no tension element disclosed in Wilson et al (US 5,116,384). The plantar member 12 can be regarded in no way as a tension element connected to a forward region of the first spring element and to a heel region of the second spring element. It can be bent in different directions, and it also transmits pressure to the dorsal member 48 (see col.5, lines 3-11, Fig.6).

Thus, it is respectfully submitted that Wilson et al (US 5,116,384) also ***fails*** to teach or suggest the present invention to one of ordinary skill in the art.

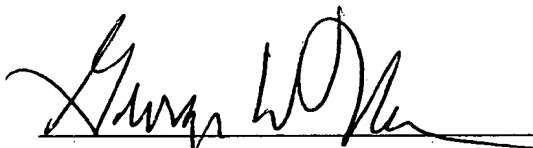
In view of the discussion above, it is respectfully submitted that the present application is in condition for allowance. An early reconsideration and notice of allowance are earnestly solicited.

Applicants believe that additional fees are not required in connection with the consideration of the within matter. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge Deposit Account No. **04-1105**.

Respectfully submitted,

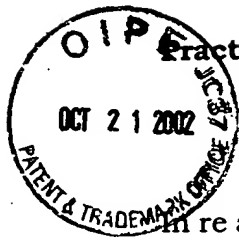
Date:

11 Oct. '02



George W. Neuner, Esq. (Reg. No. 26,964)

Dike, Bronstein, Roberts & Cushman
Intellectual Property Group of
EDWARDS & ANGELL, LLP
P.O. Box 9169
Boston, MA 02209
Tel. No. (617) 439-4444



Practitioner's Docket No. 70301.56223

PATENT

AM 3731

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **BIEDERMANN, et al.**

Application No.: **09/914,256**

Group No.: **3738**

Filed: **August 22, 2001**

Examiner: **A. Stewart**

For: **FOOT PROSTHESIS**

**Assistant Commissioner for Patents
Washington, D.C. 20231**

RECEIVED
OCT 23 2002
TECHNICAL CENTER

CERTIFICATE OF MAILING/TRANSMISSION(37 C.F.R. SECTION 1.8(a))

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

☒ deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

FACSIMILE

☐ transmitted by facsimile to the Patent and Trademark Office (703) ____-____.

Date: October 15, 2002

Signature

Denise A. Rose
Denise A. Rose
(type or print name of person certifying)

TRANSMITTAL OF REQUEST FOR RECONSIDERATION

1. Transmitted herewith is a Request for Reconsideration for this application.

STATUS

2. Applicant is
☒ a small entity. A statement:
 ☐ is attached.
 ☒ was already filed.
☐ other than a small entity.

EXTENSION OF TERM

NOTE: "Extension of Time in Patent Cases (Supplement Amendments) – If a timely and complete response has been filed after a Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.

If a timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run." Notice of December 10, 1985 (1061 O.G. 34-35).

NOTE: See 37 C.F.R. Section 1.645 for extensions of time in interference proceedings, and 37 C.F.R. Section 1.550(c) for extensions of time in reexamination proceedings.

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. Section 1.136 apply.

(complete (a) or (b), as applicable)

- (a) ☐ Applicant petitions for an extension of time under 37 C.F.R. Section 1.136 (fees: 37 C.F.R. Section 1.17(a)(1)-(4)) for the total number of months checked below:

	Extension (months)	Fee for other than small entity	Fee for small entity
<input type="checkbox"/>	one month	\$ 110.00	\$ 55.00
<input type="checkbox"/>	two months	\$ 400.00	\$ 200.00
<input type="checkbox"/>	three months	\$ 920.00	\$ 460.00
<input type="checkbox"/>	four months	\$ 1,440.00	\$ 720.00

Fee: \$ _____

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

- ☐ An extension for ____ months has already been secured. The fee paid therefor of \$ _____ is deducted from the total fee due for the total months of extension now requested.

OR

- (b) ☒ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

FEE FOR CLAIMS

4. The fee for claims (37 C.F.R. Section 1.16(b)-(d)) has been calculated as shown below:

(Col. 1)		(Col. 2)	(Col. 3) SMALL ENTITY			OTHER THAN A SMALL ENTITY		
Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Addit. Fee	OR	Rate	Addit. Fee
Total	Minus		=	x \$9 =	\$		x \$18 =	\$0
Indep.	Minus		=	x \$42 =	\$		x \$84 =	\$0
[] First Presentation of Multiple Dependent Claim					+ \$140 =	\$	+ \$280 =	\$
					Total Addit. Fee	\$___	OR Total Addit. Fee	\$0

* If the entry in Col. 1 is less than the entry in Col. 2, write "O" in Col. 3,

** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 20, enter "20".

*** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 3, enter "3".

The "Highest No. Previously Paid For" (Total or Indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

WARNING: "After final rejection or action (Section 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made." 37 C.F.R. Section 1.116(a) (emphasis added).

(complete (c) or (d), as applicable)

(c) [X] No additional fee for claims is required.

OR

(d) [] Total additional fee for claims required \$ _____.

FEE PAYMENT

5. [] Attached is a check in the sum of \$ _____.
- [] Charge Account No. _____ the sum of \$ _____.
- A duplicate of this transmittal is attached.

FEE DEFICIENCY

NOTE: *If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, (1065 O.G. 31-33).*

6. [X] If any additional extension and/or fee is required, charge Account No. **04-1105**.

AND/OR

- [X] If any additional fee for claims is required, charge Account No. **04-1105**.

 11/28/02

SIGNATURE OF PRACTITIONER

George W. Neuner (Reg. No. 26,964)
Dike, Bronstein, Roberts & Cushman
Intellectual Property Practice Group
EDWARDS & ANGELL, LLP
P.O. Box 9169
Boston, Massachusetts 02209
Tel. No. (617) 439-4444